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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARROW FASTENER CO., INC.

Appeal 2008-1275
Application 10/768,377
Technology Center 3700

Decided: July 18, 2008

Before RICHARD TORCZON, SALLY C. MEDLEY, and MICHAEL P.
TIERNEY *Administrative Patent Judges*.

Filed by TORCZON, *Administrative Patent Judge*.

MEMORANDUM OPINION AND ORDER

STATEMENT OF THE CASE

Claims 1, 4, 5 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (Ans. at 3). Claims 1, 3-5, 17, 21 and 22 are rejected under 35 U.S.C. § 102(e) as being anticipated by the prior art (Ans. at 3). The appellant, Arrow Fastener Co., Inc. (Arrow), seeks review under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

The examiner relies on the following prior art in rejecting the claims under 35 U.S.C. § 102(b) (Ans. at 3):

Yiu

US 6,854,530 B1 15 February 2005

We REVERSE the anticipation rejection based on Yiu, but AFFIRM the indefiniteness rejection under 37 C.F.R. § 41.50(c) to facilitate correction of the acknowledged problem in claim 1.

THE CLAIMED INVENTION

The claims on appeal relate to a power nailer for driving a nail into a work piece (Spec. at 0001-02). Arrow does not separately argue the claims for the § 112 rejection (Br. at 4). Arrow supplies separate arguments for the anticipation rejection of claims 1 and 17 (Br. at 4-5). The anticipation rejection of claims 21 and 22 are argued together (Br. at 5). Arrow does not offer arguments for claims 3-5, which depend on claim 1. Claims stand or fall together if they are not argued separately. 37 C.F.R. § 41.37(c)(1)(vii). We select independent claim 1 as broadly representative of the claims on appeal and reproduce it below (Br. at 7) (emphasis added):

A device for driving an attachment element into a work piece comprising:

a first drive element for driving a plunger in a first direction away from an attachment element to be driven, and [sic] said plunger storing energy in an energy storage mechanism when moved in said first direction;

a second drive element to drive said plunger in a second direction opposed to said first direction, and release stored energy in said force storage mechanism in combination with a power force from said second drive element to said plunger when moved in said second direction to drive an attachment element;

said drive element for moving said plunger in said first direction and in said second direction being the same drive element, said drive element being an electric coil; and

a position sensor for sensing a position of said plunger, *said* control receiving a signal from said position sensor when said plunger reaches a rearwardly spaced position, and driving said plunger in said second direction once said position sensor has identified said plunger as being in said rearwardly spaced position.

The emphasis indicates the word that the examiner contends makes the claims indefinite.¹

Arrow contends that Yiu does not anticipate the claimed invention because Yiu does not disclose a sensor that senses the position of the plunger in a manner recited in claims 1 and 17 (Br. at 4).

REJECTION UNDER § 112, SECOND PARAGRAPH

The offending "said" creates a problem in claim 1 because no control is previously listed as a limitation. Thus, "said control" makes no sense. Both the examiner and Arrow agree that the problem can easily be resolved by replacing "said" with "a" (Br. at 4; Ans. at 6-7).

It is often urged that if one skilled in the art could make sense of the claim, then it is not indefinite. The facts of this case show that this standard is not appropriate for all circumstances. When, as here, the problem and the solution are relatively simple *and the applicant has an opportunity to amend*

¹ Since the problem lies in claim 1, and claim 3 depends from claim 1 along with claims 4, 5 and 21, it is not clear why claim 3 is not included in the rejection as well.

the claim to cure the problem, the burden should not lie with the poor reader to guess what was intended. Claims may generally be amended while they are pending before the Office in some proceeding, so tests that have evolved for proceedings before courts do not have the same relevance here. To permit a claim to issue simply because one skilled in the art could, more likely than not, figure out what was meant is to frustrate the notice function of patent claims. Such a test turns patent claims into latent claims that must remain uncertain until a judge construes what the not "insolubly ambiguous" limitation really meant all along. Why not just amend the claim and be done with it?

Fortunately, Arrow and the examiner are eager to fix claim 1. Unfortunately, the usual opportunity to do so has passed and we have only a vague assurance that it might come again. A promise to amend is a poor basis for reversing a rejection. Fortunately, we have a tool for ensuring that the amendment that all say they wish to see, will in fact occur.

Pursuant to § 41.50(c), we explicitly state that amending "said control" in claim 1 to "a control" will overcome the rejection under §112.² By doing so, we have authorized Arrow to submit an amendment consistent with the statement.

² It would make sense to correct a similar problem in claim 17, where "said control" occurs before "a control" as well.

REJECTION UNDER § 102(e)

ISSUE

Did Arrow establish that the examiner erred in rejecting claims 1, 3-5, 17, 21, and 22 as being anticipated by the cited prior art?

FINDINGS OF FACT

1. Yiu discloses a method for driving percussion tools, including an electric hammer (Yiu, col. 1, ll. 7-9).
2. Yiu discloses that a microprocessor unit (MPU) **31** controls the operation of the tool (Yiu, col. 3, l. 67 to col. 4, l. 3).
3. Yiu discloses that the actuating device **35** for the tool includes a thyristor **37** that is coupled to a solenoid **20** (Yiu, col. 4, ll. 12-18).
4. Yiu discloses that the MPU **31** activates the thyristor **37** via a photodiode **36** (Yiu, col. 4, ll. 12-18).
5. Yiu discloses that energizing the solenoid **20** causes the plunger core **21** to move (Yiu, col. 4, ll. 30-35).
6. Yiu does not disclose a position sensor for sensing the position of a plunger core **21**.
7. Yiu does not anticipate the invention of claim 1.
8. Yiu does not anticipate the invention of claim 17.

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

Claim 1

Arrow argues that the Yiu reference does not disclose a position sensor for sensing a position of the plunger as recited in claim 1 (Br. at 4). The examiner finds that the Yiu reference has a control unit, which controls the operation of the tool based on the position of the plunger with photodiode **36** and thyristor **37** (Ans. at 4). We are not persuaded by the examiner's finding that photodiode **36** and thyristor **37** are sensing the position of the plunger. In Yiu, the MPU **31** controls the operation of the solenoid **20** that drives the plunger **21** (Findings 1-5). Yiu's photodiode **36** receives an output from the MPU **31** (Finding 4). Yiu's photodiode **36** sends a signal to the thyristor **37** so that the solenoid **20** can be activated (Findings 3 and 4). We find photodiode **36** does not send a signal to the MPU **31** based on location of the plunger but rather receives an output from MPU **31** (Finding 4). The examiner has failed to demonstrate that photodiode **36** senses the plunger position (Finding 6). Arrow's reading of Yiu is more persuasive. Yiu does not anticipate claims 1.

Claim 17

Arrow argues that the claim limitation a control receiving a signal from said position sensor "when said plunger reaches a rearwardly spaced position" is not disclosed in the Yiu patent (Br. at 5). The examiner contends that Yiu discloses the use of a position sensor in the form of a photodiode **36** (Ans. at 9). We find that photodiode **36** is not sending a signal to the control (MPU **31**) based on location of the plunger but rather receives a signal from the MPU **31** to trigger the thyristor **36**, which

activates the solenoid **20** (Findings 1-5). The examiner has failed to show in the record where photodiode **36** senses the position of the plunger (Finding 6). Arrow's reading of Yiu is more persuasive. Yiu does not anticipate claim 17.

Claims 21 and 22

Claims 21 and 22 depend on claims 1 and 17, respectively. Since we find that Yiu does not anticipate independent claims 1 and 17, we reverse the rejection of dependent claims 21 and 22.

CONCLUSION

We AFFIRM the rejection under § 112 without prejudice to amend pursuant to § 41.50(c). We REVERSE the anticipation rejection of claims 1, 3-5, 17, 21 and 22.

AFFIRMED-IN-PART

PL initials:
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Appeal 2008-1275
Application 10/768,377

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